

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

YURT *et al.*

Appl. No. 09/120,452

Filed: July 23, 1998

For: Audio and Video Transmission and
Receiving System



Art Unit: 2734

Examiner: Le, A.

Atty. Docket: 03047.0006.HS04

#13 Reg. for.
Reconsider-
ation
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Reply Under 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 26, 1999 (PTO Prosecution File Wrapper
Paper No. 12), Applicants submit the following Remarks.

It is not believed that extensions of time or fees for net addition of claims are required
beyond those that may otherwise be provided for in documents accompanying this paper.
However, if additional extensions of time are necessary to prevent abandonment of this
application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and
any fees required therefor (including fees for net addition of claims) are hereby authorized to be
charged to our Deposit Account No. 08-3038.

03047.0006.HS04

Remarks

Reconsideration of this Application is respectfully requested.

Claims 33-75 are currently pending in the application, with 33, 50 and 60 being the independent claims. Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and they be withdrawn.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 33-75 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,701,582 to DeBey ("the DeBey patent"). Applicants maintain that the rejection based upon the DeBey patent is improper under 35 U.S.C. § 102(e).

The effective filing date for the pending claims is January 7, 1991. Under 35 U.S.C. § 102(e) an issued patent that was filed in the United States prior to the invention by Applicants of the claimed subject matter may be relied upon to show anticipation. The DeBey patent issued from U.S. Application Serial No. 408,440 filed March 22, 1995, which is subsequent to the effective filing date of Applicants' claims. However, the DeBey patent claims priority as a continuation-in-part (CIP) of Ser. No. 173,865 filed December 23, 1993, which is a continuation of Ser. No. 835,947 filed as PCT/AU90/00370 on August 23, 1990, now abandoned. The earliest filing date of August 23, 1990 is apparently relied upon by the Examiner in the Office Action because all other dates in the chain of priority are subsequent to Applicants' effective filing date.

A proper rejection under 35 U.S.C. § 102(e) has not been established for at least the reason that there is no showing in the Office Action that any application in the priority chain filed prior to January 7, 1991 supports the claims of the DeBey patent. "In order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must . . . support the invention as required by 35 U.S.C. § 112, first paragraph." MPEP § 2136.03 (citing *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA

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1981)). Even if Ser. No. 835,947 could properly be accorded a filing date of August 23, 1990 for purposes of §102(e) (a premise Applicants dispute as discussed below), there is no showing in the Office Action that Ser. No. 835,947 supports the claims in the DeBey patent. For at least these reasons, a proper rejection under 35 U.S.C. § 102(e) has not, therefore, been established in the Office Action.

Moreover, it has not been demonstrated in the Office Action that the disclosure of the parent application Ser. No. 835,947 includes the subject matter that is applied against the present application to negate patentability under 35 U.S.C. § 102(e). "[W]hen the reference is a continuation-in-part of an earlier filed application . . . and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated." MPEP § 707.05(e). Applicants submit that since the chain of applications relied upon includes a continuation-in-part application, the disclosure of the issued patent may not be applied under 35 U.S.C. § 102(e) without demonstrating that the subject matter relied upon was disclosed in the application that was filed prior to the effective filing date of Applicants' claims. There is no such support provided. The rejection in the Office Action under 35 U.S.C. § 102(e) includes no demonstration that the subject matter relied upon was disclosed in any application filed prior to January 7, 1991. For this reason as well, a proper rejection under 35 U.S.C. § 102(e) has not been established.

Applicants respectfully submit that the effective filing date for Ser. No. 835,947 is April 2, 1992, after Applicants' priority date of January 7, 1991. Support for this position is contained in U.S. Patent No. 5,421,031 (copy enclosed), which issued as a continuation application of Ser. No. 835,947. Under Related U.S. Application Data on U.S. Patent No. 5,421,031, the U.S. filing date of Ser. No. 835,947 is listed as April 2, 1992.

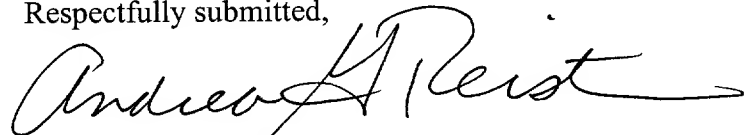
For at least the foregoing reasons, Applicants respectfully submit that neither U.S. Patent No. 5,701,582 cited by the examiner, nor U.S. Patent No. 5,421,031 qualify as prior art under 35 U.S.C. § 102(e) against the above-captioned application.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



Andrea G. Reister (Reg. No. 36,253)

Date: November 12, 1999

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November 12, 1999

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Re: U.S. Utility Application No. 09/120,452
Filed: July 23, 1998
For: Audio and Video Transmission and Receiving System
Inventors: Paul YURT *et al.*
Atty. Docket: 03047.0006.US04

Sir:

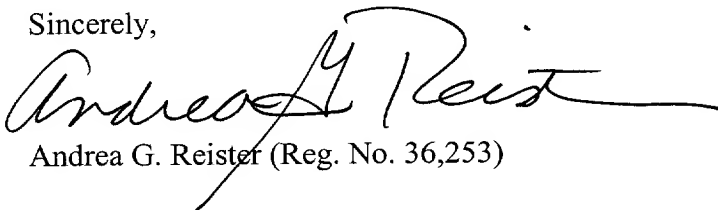
Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Reply Under 37 C.F.R. § 1.111;
2. Copy of U.S. Patent No. 5,421,031; and
3. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038. A duplicate copy of this letter is enclosed.

Sincerely,


Andrea G. Reister (Reg. No. 36,253)

Enclosures